




IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Assignee's Docket No.: 9794.00)
Group Art Unit: 3627)
Serial No.: 09/992,363)
Examiner: James McClellan)
Filing Date: November 16, 2001)
Title: Metacommerce System)

REPLY BRIEF

CERTIFICATE OF MAILING

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Gregory A. Welte

SUMMARY OF MAJOR POINTS OF THIS REPLY BRIEF

re: DEFINITION OF "PORTAL"

Point 1

Many claims recite "receiving an identity signal from a transponder" "at a portal to an enclosure," or something similar.

The Examiner's Answer ("Answer" herein) defines "portal" as "a web site that serves as a gateway to the Internet." Under this definition, for example, a person's ISP, Internet Service Provider, acts as a "portal."

Appellant points out that such a "portal" has no "enclosure," as claimed. Nor is there found the claimed "identity signal,"

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received from a "transponder."

This applies to independent claims 1, 6, 11, 14, 19, and 24.

Point 2

Other claims recite (1) detecting entry of a person through a "portal," and (2) issuing an award to the person in response to the entry.

The Answer again relies on the definition of "portal" given above. The Answer asserts that paragraph 7 of Hardesty states that an incentive is offered to a person to visit a web site, and that this shows the claim recitation.

However, the Answer has things backward. The claim states that the award is given **in response to** the entry of the "portal."

Hardesty states that the incentive is offered to induce a person to visit a web site. Plainly, the incentive in Hardesty is given **prior to** the visit to the web site. That does not show the claims in question.

Point 3

Even if, contrary to Point 2, above, the incentive in Hardesty is given **after** the person visits the web site, the claims are still not found in Hardesty.

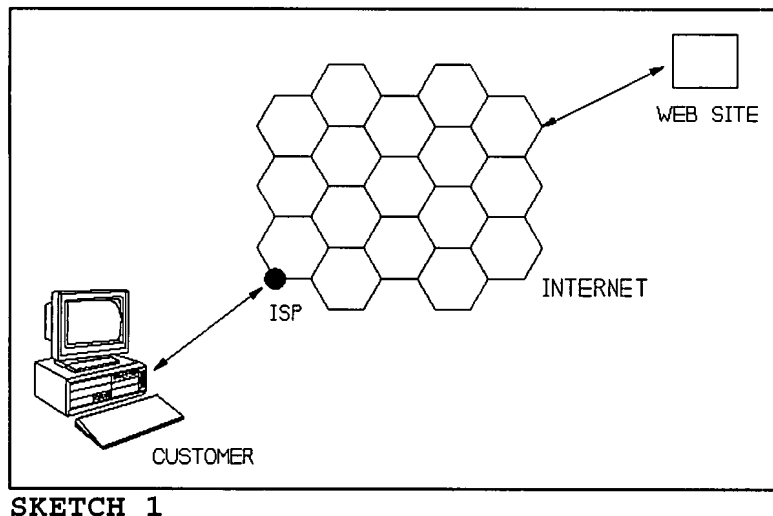
The reason is simple. The "portal" in Hardesty does not issue the incentive.

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The Answer's definition of "portal" is here repeated:

Portal - a web site that serves as a gateway
to the Internet.

Sketch 1, below, illustrates the definition graphically.



The Answer's "portal" is the ISP, Internet Service Provider, such as AOL, America On-Line. The CUSTOMER dials up the ISP, in order to gain access to the INTERNET.

But, under the Answer's interpretation of the claims, either the WEB SITE issues the award, or some agency affiliated with the web site does. And that is done **after** the CUSTOMER "enters."

The "portal"/ISP is not involved in that process.

The "portal"/ISP in Hardesty does not detect entry of the

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CUSTOMER into the web site and issue an award in response.

The "portal"/ISP does not perform the claimed operations.

Point 4

The Answer is re-defining a term ("portal") used by Appellant in the Specification. The specification, in "Additional Consideration" number 1 on page 7, states

-- "The discussion above was framed in terms of a customer entering a door in a building," and

-- "In the more general case, any type of portal to an enclosure is contemplated, such as a sports arena or stadium, or even a fenced area, such as a fairground."

This "Additional Consideration" plainly gives one definition of "portal," namely, "a door in a building."

The specification is not required to say "Here is a definition of 'portal.'" The specification is interpreted by a person skilled in the art. This "Additional Consideration" clearly sets forth a definition.

In addition, this "Additional Consideration" plainly states that, **in the GENERAL case**, the "portal" is "to an enclosure."

Thus, the term "portal," in the claims, refers to "a door in a building" or "a portal to an enclosure."

The Answer is not allowed to re-define that word, particularly

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in terms of a portal in a computer system, which has no relation whatever to the door in a building which the Appellant's specification discusses.

Further, the Answer is assigning a definition to "portal" which is not supported by the specification. Take claim 1, for example. The Answer re-writes claim 1(a) as

1. A method, comprising:

a) at a ~~portal to an enclosure~~ web site that serves as a gateway to the Internet, receiving an identity signal from a transponder.

Such re-writing is not allowed.

If Appellant attempted to amend claim 1 to read as above, the PTO would immediately object, on the grounds of lack of support in the specification.

The Answer cannot be allowed to apply a claim to subject matter which Appellant would be prohibited from covering by amendment.

Further, the claim, as re-written by the PTO, now fails to read on Appellants embodiments, given in the specification. That shows that the Answer is using a **different** definition of the term "portal." The Answer is not applying the term "more broadly."

Point 5

The Answer asserts that (1) the specification gives no

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definition of "portal," and (2) the specification's examples do not qualify as a definition.

As to (2), the undersigned attorney points out that his desk-dictionary gives one definition of "portal" as "door, enclosure." That is a definition, given in a dictionary, by way of two examples.

Examples, in general, qualify as definitions. They provide examples of what the claim term covers. They may not be exhaustive, but that does not matter, because a definition in general in a patent is not exhaustive, unless good reason exists to make the definition exhaustive. One reason is that an exhaustive definition will thereby limit the scope of the term defined to that definition. That is risky.

As to item (1), Point 4, above, showed that the specification provided a definition.

Point 6

The Answer asserts that it is entitled to interpret "portal" as broad as reasonably possible. That is not correct.

The MPEP (quoted herein) states:

- The interpretation must be **consistent with the specification;**
- When resort is taken to a dictionary, and multiple definitions are found therein, the

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definition which corresponds to the
Specification must be used.

The Answer cannot use its definition.

Point 7

The Answer is not, in fact, giving a "broader" definition to the term "portal."

Instead, the Answer is selecting a **different** definition, and using that **different** definition.

That is, the specification gives a **specific example** of a "portal," namely, "a door in a building." The desk-dictionary of the undersigned attorney gives one definition of "portal" as "door or entrance." And the examples of the specification clearly refer to detecting a person at a door to a building.

Therefore, the claim language covers detecting a person at a door to a building. That cannot be denied.

The Answer utilizes a **different** definition of "portal."

That is not "broadening" the term "portal." That is **changing the definition**.

From another point of view, many words in the English language have multiple different definitions. The word "mine" means

- (1) an excavation in the earth from
which minerals are extracted, or
- (2) a packaged explosive for destroying

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people and equipment.

In effect, the word "mine" acts as **two different words**, having two different meanings.

This type of conclusion applies to the claim term "portal." The Answer is, in essence, substituting a **different word** for the claim term.

COMMENT

Not all points made in this Summary are repeated below.

END SUMMARY

Reply to Answer, Pages 1 - 8

This part of the Answer contains boilerplate, and a restatement of the Final Office Action ("Final Action" herein).

No reply is needed to the boilerplate.

The Brief addressed the Final Action.

Reply to Answer, Page 8, Second Full Paragraph (Which Begins with "On page 11 . . .")

Point 1

Appellant points out that the language in several claims is not merely "portal," but "portal to an enclosure."

That claim language clearly refers to a **physical portal** to a **physical enclosure**.

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That language does not read on "portal" as defined by the Answer.

Point 2

Even considering the term "portal" outside the phrase "portal to an enclosure," the Answer's contentions lack support, for several reasons.

REASON 1

The Answer relies on a dictionary definition of "portal," which defines the term as "a web site that serves as a gateway to the Internet." Plainly, this definition refers to the "web site" which a person's ISP, Internet Service Provider, operates. A person contacts that ISP, as by dialing up using a modem, and then uses the ISP to surf the Internet, as by contacting www.google.com.

Even if the Answer's definition be used, Appellant points out that either

- 1) the claims are not found, or
 - 2) the application of that definition makes no sense, or
- both (1) and (2).

For example, claim 1 recites:

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a) at a portal to an enclosure, receiving an identity signal from a transponder.

Under the Answer's definition, the claimed "portal" is a "web site that serves as a gateway to the Internet."

In applying this definition to claim 1, Appellant asks:

- Where is the claimed "transponder" ?
- Where is the claimed "enclosure" ?
- As to the claimed "enclosure," how does the Answer's web site, which the Answer defines as a "portal," qualify as the claimed "portal" "TO" the claimed "enclosure" ?

Appellant further points out that this claim phrase contains several elements:

- a transponder,
- a portal,
- an enclosure,
- "at" the "portal," "receiving an identity signal," and
- the "identity signal" is "from" the "transponder."

The undersigned attorney's desk-dictionary defines "transponder" as "a radio set which transmits an identification signal."

Where are these elements, including the "transponder," and

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where are the recited operations, in the "web site" (eg, an ISP) which the Answer uses to show the claimed "portal" ?

These elements are not present.

These comments apply to claims 1, 6, 11, 14, 19, and 24.

REASON 2

Claim 24 recites:

a) means for receiving an identity signal from a transponder associated with a person at a portal to an enclosure.

Under the Answer's definition of "portal," Appellant asks "Where is the 'person at a portal to an enclosure,' as claimed ?"

-- Where is the "person" at the Answer's web site (ISP), which supposedly shows the "portal" ?

-- Where is the "transponder associated with" that "person" ?

-- Where is the "enclosure" ?

This comment applies to claims 6, 11, and 19.

REASON 3

The Answer's basic supposition is incorrect, for several reasons

One reason is that the Answer asserts that the Examiner may

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read the claim limitations as broadly as possible. But even if such a broad reading is allowed, the Answer **is not doing that**.

Instead, the Answer is using **different definitions** of claim terms. Under those **different definitions**, the claims no longer read on the embodiments set forth in the specification.

That is not reading a claim term "broadly." That is **using a different definition**.

This will be further explained.

In the English language, some words have more than one meaning, and those meanings are not related to each other.

-- "Dumb" means

- (1) stupid,
- (2) silent, or
- (3) lacking in some characteristic, such as processing power (as in a dumb terminal) or propulsion (as in a dumb barge).

-- "Dugout" means

- (1) a boat hollowed out from a log, or
- (2) a shelter on the side of a baseball diamond which houses players' benches (note that the shelter need not be "dug").

-- "Mine" means

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- (1) an excavation in the earth from which minerals are extracted, or
- (2) a packaged explosive for destroying people and equipment.

In these examples, selecting one definition over another does not apply a "broader" definition to the terms. Instead, such selecting of a definition applies a **different** definition.

A second reason is that the Answer's supposition is simply incorrect. The PTO does not "read the claim limitations **as broadly as reasonably possible**," as the Answer asserts. There is at least one **additional requirement**. That "broad" "reading" must be consistent with the Specification. The MPEP explains this.

The MPEP sections cited immediately below state that

- claim terms are interpreted **consistent with the specification**, and
- if a dictionary definition of a term contains multiple meanings, then the specification is used to determine which meaning is proper.

The MPEP sections are set out here. MPEP § 2111 states:

CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given their broadest

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reasonable interpretation **consistent with the specification.**" (Citation.) (Emphasis supplied.)

This MPEP section cites a 2005 decision of the CAFC (Phillips v. AWH Corp.), which states:

. . . [The PTO] determines the scope of claims in patent applications **not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art.**

Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. 37 CFR 1.75(d)(1).

MPEP § 2111.01(I) states that the "plain meaning" is used, and another section, discussed immediately below, states that "plain meaning" is determined by the specification:

§ 2111.01(I)

Plain Meaning

. . . the USPTO must give claims their broadest reasonable interpretation in light of the specification. . . .

This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the

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specification.

§ 2111.01(III)

**"PLAIN MEANING" REFERS TO THE
ORDINARY AND CUSTOMARY MEANING GIVEN
TO THE TERM BY THOSE OF ORDINARY
SKILL IN THE ART**

The ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art.

. . .

It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims.

. . .

In construing claim terms, the general meanings gleaned from reference sources, such as dictionaries, must always be compared against the use of the terms in context, and the intrinsic record must always be consulted to identify which of the possible dictionary meanings is most consistent with the use of the words by the inventor.

. . .

If extrinsic reference sources, such as dictionaries, evidence more than one definition for the term, the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicant's use of the terms.

. . .

This MPEP section cites a 1998 CAFC decision (Renishaw), which

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states:

Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings.

Additional Point 1

The Answer, page 8, third line from end, asserts that Appellants examples in the Specification do not qualify as definitions. Appellant points out that no authority for this proposition has been cited.

Further, a reasonable reading of "Additional Consideration" number 1 on page 7 of the specification is that one definition of "portal" is a "door in a building."

That is, consider the statement "One definition of 'portal' is 'a door in a building.'" That statement is, in effect, contained in "Additional Consideration" number 1 of the specification. "Additional Consideration" number 1 **explicitly** states the following:

- The specification discussed a customer entering a door in a building.
- "In the more general case, any type of portal to an enclosure is contemplated."
- Examples of the "more general" "enclosure" are given, such as "a sports arena" "stadium,"

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or "a fenced area, such as a fairground."

Therefore, "Additional Consideration" number 1 provides **one specific definition of "portal."**

Additional Point 2

"Additional Consideration" number 1 gave examples of a "portal." One example is a "door in a building."

Thus, the claim term "portal" can clearly refer to "a door in a building." Appellant is not required to set forth an exhaustive definition as to how all-encompassing the term "portal" is.

From another point of view, since

- 1) the undersigned attorney's dictionary gives "door" as one definition of "portal,"
- 2) the specification repeatedly speaks of a "door" to a building, and
- 3) the "door" qualifies as support for the claim term "portal,"

the specification thereby gives "door" as one definition for "portal."

This conclusion is supported by MPEP § 2173.05(n), which states:

. . . the terms and phrases used in the claims must find clear support or antecedent basis in the description **so that the meaning of the terms may be ascertained by reference to the**

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description.

The term "portal to an enclosure" in the claims is supported by the language "door" in a "building" in the specification. Thus, the "meaning" of the former term ("portal to an enclosure") is "ascertained" by "reference" to the latter term ("door" in a "building").

Since the "meaning" of one term (call it term A) is "ascertained" by "reference" to another term (term B), term B gives a definition to term A. That is the definition of "definition."

Additional Point 3

One point is here repeated, because it is considered important.

The claims read upon the embodiments discussed in the specification. That is undisputed by the Examiner.

When the term "portal" is re-defined by the Answer, the claims no longer read on the embodiments in the specification.

That fact, by itself, indicates that the Answer is not "broadening" the definition. Instead, the Answer is using a **different** definition.

The Answer is re-defining the claim terms. That is not allowed.

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**Reply to Answer, Page 8, Part of Second Full Paragraph
Which Begins with Sentence Beginning with
"In addition, Appellant . . ."
(Second Line From Bottom, Page 8)**

Some claims recite a "portal to an enclosure." Appellant is not required to further define any terms, since that phrase clearly does not apply to a "portal," as defined by the Answer.

**Reply to Answer, Page 9, Part of First Paragraph
Which Begins with Sentence Beginning with
"Since Appellant insisted . . ."
(Fifth Line From Top, Page 9)**

Appellant points out that the Answer's conclusion is directly contrary to the claim language itself.

Some claims recite a "portal" "at" an "enclosure," and a "person" at that "portal." That language cannot possibly be interpreted as covering an "Internet shopping environment," as the Answer asserts.

Reply to Answer, Page 9, First Full Paragraph

Point 1

The Brief, addresses this point, for example, on page 17, section entitled "POINT 2."

Appellant points out that the claims state that bonus points are awarded to a customer for merely entering the store. Significantly, the bonus points are awarded **after** entry of the

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customer is detected.

The Answer cites Hardesty, paragraph 7, as showing this. The Answer, bottom of page 9, states:

Hardesty grants reward benefits for merely visiting an online store as opposed to most other businesses that require a customer to make a purchase.

Appellant points out that, even if this statement be correct, it does not show the claims. Hardesty mentions "reward programs" that "provide . . . incentives to consumers" "to 'visit' certain web sites." (Paragraph 7.)

Plainly, Hardesty's "incentives" are given **prior to the "visit" by the customer**. Hardesty does not state that the "incentives" are given **after** the "visit."

The claims state that the award is given after, or in response to, the customer's entry of the "portal" to "an enclosure."

**Reply to Answer, Page 10, First Paragraph
Which Begins with "On pages 11 - 12 . . ."**

Point 1

Appellant points out that the Answer is reasoning backward.

The motivation used by the Answer for combining the references is that the combination produces a particular result.

That is backward reasoning, because it **assumes** the existence of the combined references, **and then finds** the particular result.

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That reasoning does not act as a teaching for combining the references in the first place.

The Answer has not show how pursuit of that particular result leads to the combination of references showing the invention. (See Point 3, below.)

Point 2

The Answer's motivation for combining the references is that the "incentive" attracts customers to a store.

However, Hardesty, paragraph 7, explicitly discusses offers of incentives to induce customers to "purchase . . . goods" "off-line" (that is, in a physical store).

Thus, if the goal is to attract customers to a store, one need merely follow the teachings of Hardesty. There is no reason to combine Hardesty with the other reference.

From another point of view, as a matter of logic, there is no reason to add the other reference to Hardesty, to attain the Answer's goal. Hardesty, by itself, attains the goal of attracting customers to a store. As a matter of logic, the goal does not suggest combining the references.

Point 3

Even if the Answer's goal be accepted, the Answer has not shown why the goal should lead to the claimed invention, as opposed

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to other approaches to lure customers into a store.

This is a result of the fact that, again, the Answer's motivation is merely a supposed characteristic of the references, once combined.

Restated, the Answer has merely asserted that the combination of references leads to a particular (supposed) result, namely, attracting customers to a store.

But the Answer has not shown how that particular desired result leads to the combination of references, showing the invention.

The Answer must show how its goal leads to the specific recitations in the claims, as opposed to another approach to luring customers into stores, such as strewing hundred-dollar bills in front of the store's building.

**Reply to Answer, Page 11, First Full Paragraph
Which Begins with "On page 12 . . ."**

Point 1

The Answer asserts that Hardesty "discloses awarding bonus points for merely visiting a store." Appellant points out that this is irrelevant, because the claims do not recite merely that.

The claims recite, for example, (1) detecting a customer in a particular way, at a particular place, and (2) making an award in response to the detection.

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Further, Hardesty plainly awards the "points" **prior** to the visit by the customer. That does not show the claims.

Point 2

Claims 1, 6, 14, 19 and 31, and dependents, explicitly state that no transaction or purchase is required.

Claim 9 states that the bonus is awarded "in response to the entry," and no purchase is recited.

**Reply to Answer, Page 11, Second Full Paragraph
Which Begins with "On page 13 . . ."**

The Brief addressed the rejection of claims 14 - 26.

The Final Action, page 4, rejected claims 13 - 21, 24, and 26 under section 102, based on Hardesty.

The Final Action asserted that a visit to a web site in Hardesty showed the physical "means" recited in the claims.

The Answer's invocation of Ogasawara is irrelevant to these rejections, because they are based on Hardesty.

**Reply to Answer, Page 11, Third Full Paragraph
Which Begins with "On page 20 . . ."**

The Brief addresses this paragraph. The main point is that, since a web site has no fixed location, the claimed "entry" cannot occur. That is the claim language which cannot be found in the reference.

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Appellant will explain further the lack of a fixed location.

What happens when a person contacts a "web site" ? That person's computer transmits a request and a URL onto the Internet. The URL is an "address" of a computer. The Internet, because of its structure, delivers the request to that computer, acting like a post office, as it were.

That computer receives the request and it, or an associated computer, transmits a bunch of data, such as text, pictures, etc. to the computer of the person making the request. That data can include items sent from yet **other computers**, such as "pop-up ads."

Thus, Appellant asks rhetorically, "Where is the 'web site' actually located ?" Multiple computers, at different locations, can supply the data which creates the images on the person's computer. Those images act as the web site.

**Reply to Answer, Page 11, Last Full Paragraph
Which Begins with "On page 20 . . ."**

Point 1

Hardesty's placement of "visit" in quotes is clear acknowledgement that "visit" is being used in a fanciful, and non-traditional, manner.

-- No person enters the web site.

-- No person travels through the telephone wires to reach the web site.

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-- If the person uses a cellular modem, or satellite connection, no person flies through the air to reach the web site.

Point 2

At some time in past history, such as the 1970's or 1980's, "web sites" did not exist. Thus, the phrase "visit a web site" had no meaning. To repeat: the term "visit" had no meaning which related to web sites.

With the arrival of web sites, the term "visit" was fancifully applied to them. But that use of the word created a completely different meaning than used previously.

Point 3

The claims do not recite the term "visit." The issue is whether the claim language, of "detecting" a "transponder" at a "portal to an enclosure," when read in light of the specification, is shown by "visiting" a web site in Hardesty.

**Reply to Answer, Page 12, First, Second, and Third Paragraphs
The First of Which Begins with "On page 21 . . ."**

The issue of the term "portal" has been addressed herein.

As to any admission by Appellant that "portal" has two meanings (third paragraph), Appellant repeats the relevant part of

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the Brief:

Numerous words in the English language have more than one meaning. Applicant has no control over that.

For example, "box" means (1) to engage in the art of fisticuffs and (2) to enclose in a cardboard package.

Similarly, "portal" can mean (1) a physical door and (2) an entry point into a computer network.

The meaning which corresponds to the Specification must be used.

(Brief, page 22.)

**Reply to Answer, Paragraph Bridging Pages 12 and 13
Which Begins with "On page 22 . . ."**

The Answer asserts that, when a person enrolls in the loyalty program in Hardesty, the person identifies himself "to the web site."

Point 1

Appellant points out that this assertion is completely unsubstantiated. Hardesty merely mentions "incentives" "to consumers" "to 'visit' certain web sites." (Paragraph 7.)

Hardesty provides no details.

There is no reason to conclude that the consumers "enroll" in any "program." For example, Hardesty could hand out keychains which contain valuable gemstones, and a tag which says "Visit this

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web site: www.this_web_site.com"

That is an incentive, but without any enrollment.

Point 2

The Answer is relying on the Doctrine of Inherency. MPEP § 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE
TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the examiner must **provide a basis in fact and/or technical reasoning** to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

No "basis in fact and/or technical reasoning" has been given, as required.

Point 3

Even if the Answer's assertion be correct, it still does not show the claim recitations.

The Answer's "enrollment" would occur **once**. That does not show the claimed identification upon entry of a "portal" "to an enclosure," which can occur many times.

Further, the Answer's "enrollment" does not imply that the web site identifies the customer when the customer "visits" the web site. An analogy will illustrate this.

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The undersigned attorney recently joined an educational web site, which provides lessons on how to use a mechanical knitting machine, and paid a fee. He obtained a "user name" and a password.

Now, to gain access to the lessons, he logs into the web site, enters the "user name" and password, and gains access to the lessons.

But the web site does not identify him when he arrives. He identifies himself.

It would seem that any "program" in Hardesty would operate the same way. This conclusion is particularly appealing, because such operation is technically very simple, and requires no development of hardware or software, since many web sites use this type of approach.

**Reply to Answer, Page 13, First Full Paragraph
Which Begins with "On page 27 . . ."**

The Brief's statement regarding separate patentability was made because, when the Brief was written, the rules on Appeal Briefs stated that separate patentability of claims in a group must be shown. Otherwise, all claims in a group could be rejected together, based on the broadest claim in the group, without analysis of narrow claims.

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**Reply to Answer, Page 13, Second Full Paragraph
Which Begins with "On page 29 . . ."**

Point 1

The facts that (1) the references are contradictory, and (2) the Answer agrees that they are contradictory, indicates that the references teach away from being combined.

To combine them, the Examiner must provide a teaching which overcomes the contradiction.

Point 2

The references contain contradictory teachings (one reference awards bonus points, the other does not). The Examiner arbitrarily selected one teaching, to the exclusion of the other. The Examiner provided no explanation of why one teaching was selected, to the exclusion of the other.

Consequently, it is reasonable to assume that Appellant's claims are the basis for the selection. That is not allowed.

MPEP § 901.03 states:

Pending Applications

Except as provided in 37 CFR 1.11(b), pending U.S. applications are . . . not available as references.

Under section 112, the claims are part of the specification. The claims cannot be used as a motivation for selecting items

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in references, and combining the items.

**Reply to Answer, Page 13, Last Paragraph
Which Begins with "On page 33 . . ."**

The Brief, beginning on page 33, addresses the Answer.

**Reply to Answer, Page 14, First Full Paragraph
Which Begins with "On page 35 . . ."**

The Brief addresses this paragraph.

Appellant points out that the Answer, in this paragraph, merely sets forth conclusory assertions that the rejections are proper, but without offering any evidence.

**Reply to Answer, Page 14, Second Full Paragraph
Which Begins with "On page 36 . . ."**

The Answer has now **completely changed the rejection.**

And the rejection, both in the Final Action, and now as altered by the Answer, fails to qualify as a valid 103 - rejection.

Point 1

The Brief, page 35, set forth the text of the rejection of claim 11. Then the Brief explained that this rejection failed to identify the individual claim elements of claims 11 and 13.

Now the Answer asserts that those claim elements are found in Ogasawara. And the Answer asserts that this reliance on Ogasawara

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was found in the Final Action.

As to the latter (the reliance), Appellant respectfully points out that no reliance is found in the Final Action.

On page 4, section 7, the Final Action lists some claims, and erroneously stated that they are rejected as obvious, based on **Ogasawara alone**. (The statement is erroneous because, as will be explained, some of the claims are rejected based on both Ogasawara and Hardesty.)

The Final Action rejected claim 1, based on Ogasawara alone.

Then, on page 5, sixth paragraph et seq., the Final Action rejects claims 11 and 13. But it does so by apparently (1) assuming that the rejection of claim 1 serves to reject part of claim 11 and (2) adding Hardesty, to show some "identity signal" supposedly found in claim 11.

Appellant points out that this rejection makes no sense. And the Answer has clarified nothing.

It makes no sense for at least four reasons.

One reason is that claim 1 recites an "identity signal." If claim 1 was rejected based on Ogasawara, as on page 4 of the Final Action, then there is no need to find that "identity signal" in the other reference, Hardesty, as does the Final Action on page 5.

A second reason is that claim 1 recites different subject matter than does claim 11. The Final Action has not explained what part of claim 11 is being covered by the rejection of claim 1.

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A third reason is that claim 11(b) recites

"b) in response to the identity signal,
transmitting a message to a location which is
accessible by the person."

The Final Action relies on a "message" in paragraph 46 of Hardesty to show the claimed "message." But the "message" of Hardesty is not sent "in response to the identity signal."

A fourth reason is that **TWO** "identity signals" are now present. One is supposedly found in Ogasawara, as used to reject claim 1. The other is supposedly found in Hardesty. (Final Action, page 5, second-to-last paragraph.)

Appellant submits that the combination of the Final Action, plus the Answer, fails to set forth a prima facie case of obviousness, as required.

Point 2

The elements of claims 11 and 13 have still not been shown in the references.

For claim 11, the Answer relies on Hardesty's paragraph 46.

However, that paragraph 46 discusses nothing related to any bonus points in either reference. Paragraph 46 discusses generalized funds-transfers, as in checking accounts.

Further, claim 11 recites

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b) in response to the identity signal, transmitting a message to a location which is accessible by the person.

Hardesty's paragraph 46 utterly fails to show this claim recitation.

-- The operations in paragraph 46 are not done "in response to the identity signal," as claimed.

-- As explained above, **TWO** "identity signals" are now present. The Answer has not explained which one the "message" of paragraph 47 responds to.

-- Whatever "message" is transmitted in paragraph 46 is not "accessible to the person," as claimed. One reason is that, under the claim, the "person" is that which entered the "portal to an enclosure." Any "message" in paragraph 46 relates to transfers from one bank account to another. How is that "message" "transmitted" "to a location which is accessible by the person," as claimed ? That person is in the "enclosure."

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**Reply to Answer, Page 15, First Full Paragraph
Which Begins with "On page 38 . . ."**

In apparent agreement with the discussion above, namely, that Hardesty's paragraph 46 fails to show claim 11(b), the Answer now invokes two additional paragraphs, namely 37 and 38.

Paragraph 37 states that Hardesty's system relates to procedures and reporting practices of "tax deferred investment vehicles." Nothing in that paragraph relates to claim 11(b), and nothing is done "in response to the identity signal," as in claim 11(b).

Paragraph 38 states that the sponsors of the investment vehicles of paragraph 37 can communicate special offers with the customers, in various ways. Again, nothing in that paragraph relates to claim 11(b), and nothing is done "in response to the identity signal," as in claim 11(b).

**Reply to Answer, Page 15, Second Full Paragraph
Which Begins with "On page 47 . . ."**

Point 1

The Answer asserts that it has a "valid reason . . . to incorporate the features of Biffar" with the other two references.

Appellant points out that "a valid reason" is not the test of obviousness. MPEP § 706.02(j) states:

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. . . the examiner should set forth in the Office action:

. . .

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) **an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.**

To establish a prima facie case of obviousness, three basic criteria must be met.

First, **there must be some suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

. . .

The teaching or suggestion to make the claimed combination . . . must . . . be found in the prior art and not based on applicant's disclosure.

The existence of a "valid reason" is not sufficient. A "teaching" or "suggestion" is required.

And the "teaching or suggestion" must be found in the prior art.

Point 2

The Answer, bottom of page 15, appears now to rely on Hardesty's paragraphs 37 and 38, rather than Biffar.

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However, those paragraphs do not correspond to the claims in question. Claims 12 and 25, speaking generally, recite

- 1) identifying a customer "at a portal to an enclosure" using a "transponder," and
- 2) sending an e-mail message to the identified customer.

Paragraphs 37 and 38 of Hardesty were discussed above. They do not show these recitations.

Specifically, even though paragraph 38 discusses e-mail messages, those are not done "in response" to the "identity signal," as claimed.

Point 3

This obviousness rejection has the same flaw as the other.

The rationale given for combining the references is that a certain result is obtained. But that rationale **presumes** the existence of the combination, and then deduces the result from the combination.

The rationale must show that the combination of references proceeds from seeking the result, not that the result proceeds from the combination.

Further, the prior art must show the desirability of the result, either by a teaching in a reference, or knowledge of the skilled artisan.


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Further still, the mere presence of a desirable feature in a combination of references is not a basis for an obviousness rejection. If it were, then every invention would be obvious, because every combination of references has some desirable feature.

CONCLUSION

Appellant requests that the Board overturn all rejections, and pass all claims to issue.

Respectfully submitted,


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